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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,012	03/16/2004	Ivan To	THOLAM P226US	4415
20210 7590 07/29/2009 DAVIS & BUJOLD, P.L.L.C. 112 PLEASANT STREET CONCORD, NH 03301				
EXAMINER				
MILLER, WILLIAM L				
ART UNIT		PAPER NUMBER		
3677				
MAIL DATE		DELIVERY MODE		
07/20/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/803,012

**Applicant(s)**

TO, IVAN

**Examiner**

William L. Miller

**Art Unit**

3677

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10, 12, 13, 15 and 17-25 is/are pending in the application.
- 4a) Of the above claim(s) 12, 13, 17, 18 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10, 15, 19 and 21-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 20090213, 20090707
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Priority*

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Canada on 03-18-2003. It is noted, however, that applicant has not filed a certified copy of the Canadian application as required by 35 U.S.C. 119(b).

### *Election/Restrictions*

2. Claims 12, 13, 17, 18, and 20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 03-15-2006.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 10, 15, 19, 24, and 25 are rejected under 35 U.S.C. 102(c) as being anticipated by Robinson et al. (US#6843010).

5. Regarding claim 10, Robinson discloses a luminescent signage component comprising: a one piece body 12 in the form of a sign plate made from a single layer of transparent material, having a first face 17 and an opposing second face; at least one inlaid cavity 22 (etched character) in the body defining a “real image” via its shape of one of alpha-numeric indicia or

graphic indicia, and the at least one cavity being closed by an integrally formed transparent window (portion) positioned across the second face; luminescent epoxy 16 filling the at least one cavity (col. 2, lines 56-59), such that the one of alpha-numeric indicia or graphic indicia emits a luminescent glow in the event of a power failure; and a constant light source 14 lighting the at least one inlaid cavity.

6. Regarding claim 15, Robinson discloses an exit sign comprising: a sign enclosure 11; a constant light 14 mounted in the interior of the enclosure and thus constantly illuminating the interior of the sign enclosure; a one piece sign plate 12 made from a single layer of transparent material mounted in the enclosure, the sign plate having a first face 17 and an opposing second face, at least one inlaid cavity 22 (etched character) in the sign plate defining a real image of letter spelling the word EXIT, the at least one cavity being closed by an integrally formed transparent window (portion) positioned across the second face, the alpha-numeric indicia of the sign plate bearing letters spelling the word EXIT, luminescent epoxy 16 filling the at least one inlaid cavity (col. 2, lines 56-59) between the first face and the second face resulting in the letters spelling the word EXIT being formed with the luminescent epoxy, the at least one inlaid cavity of the sign plate being backlit via reflection by the light source, such that light illuminates the letters and activates the luminescent material so that the letters EXIT give off a luminescent glow making them visible when power to the light source is disrupted.

7. Regarding claim 19, wherein the at least one inlaid cavity 22 in the sign plate extends toward the second face a distance “substantially” midway between the faces.

8. Regarding claim 24, a reflective coating is located on the base of the cavity (see col. 2, lines 59-63), namely the upper perimeter edge of the cavity as the coating is applied to a back surface of the epoxy after application to the cavities.
9. Regarding claim 25, the lighting is backlighting via reflection.
10. Claims 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Woog (US#5607222).
11. Regarding claim 21, Woog discloses an exit sign comprising: a sign enclosure 12,16 defining an interior of the enclosure and having an opening communicating with an exterior of the sign enclosure; a light source 20 being mounted within the interior of the enclosure; and a one piece sign plate 14 being made from a single layer of material mounted in the enclosure, the sign plate having an exterior facing surface and an interior facing surface, and at least one cavity 18 (inscription, col. 2, lines 25-27) being formed and inlaid in the exterior facing surface and extending "substantially" midway between the exterior facing surface and the interior facing surface, the at least one cavity defining at least one alpha-numeric indicia, the sign plate having transparent portions only located between the at least one cavity and the interior facing surface (col. 2, lines 25-31), the at least one cavity being filled with a luminescent epoxy (luminescent paint, col. 2, lines 25-28) such that the luminescent epoxy forms the alpha-numeric indicia defined by the at least one cavity; and the light source directly illuminating the interior facing surface of the sign plate such that the light passes through the interior facing surface of the sign plate and then through the luminescent epoxy prior to exiting the sign enclosure.

12. Regarding claim 22, the light source is directly adjacent the interior facing surface of the sign plate such that light radiating from the light source constantly (continually recurring) illuminates the interior facing surface and the transparent portions of the sign plate to illuminate and charge the luminescent epoxy.

13. Regarding claim 23, Woog discloses an exit sign comprising: a sign enclosure 12,16 defining an interior of the enclosure and having an opening communicating with an exterior of the sign enclosure; a light source 20 being mounted within the interior of the enclosure; and a one piece sign plate 14 being made from a single layer of material mounted in the enclosure, the sign plate having an exterior facing surface and an interior facing surface, and first, second, third and fourth cavities 18 (inscription, col. 2, lines 25-27) being formed and inlaid in the exterior facing surface and extending “substantially” midway between the exterior facing surface, and the interior facing surface, the first cavity defining the letter E, the second cavity defining the letter X, the third cavity defining the letter I, and the fourth cavity defining the letter T, the sign plate having transparent portions only located between the cavities and the interior facing surface (col. 2, lines 25-31), each of the first, the second, the third and the fourth cavities being filled with a luminescent epoxy (luminescent paint, col. 2, lines 25-28) such that the luminescent epoxy forms and spells the word EXIT; and the light source being directly adjacent the interior facing surface of the sign plate and directly and constantly (continually recurring) illuminating the interior facing surface of the sign plate such that the light passes through the interior facing surface of the sign plate and then through the luminescent epoxy prior to exiting the sign enclosure.

14. It is noted in claims 21-23, a constant light source is not being claimed as in claims 10 and 15.

***Response to Arguments***

15. Regarding claims 10 and 15, the applicant argues the etched characters in Robinson do not provide a cavity defining a real image of one of alpha-numeric or graphic indicia. The examiner disagrees and as the term "etched" is known in the art to imply surface removal and thus inherently an inlaid cavity in the surface where the surface was removed. Merriam Webster's Collegiate Dictionary (Tenth Addition) provides the following definition of "etch" which is "to produce (as a pattern or design) on a hard material by eating into the material's surface (as by acid or laser beam)." The term "etched" is being viewed as assuming its ordinary meaning which implies surface removal and thus an inlaid cavity. This resultant cavity defines a real image, namely the letters EXIT. The epoxy is then applied to and thus inherently fills the created cavity (see col. 2, lines 56-69). With respect to mirrored versus non-mirrored images, the phrase "real image" is not limited to either in the claim.

16. Regarding claim 24, the applicant argues only a cavity defining a non-mirror image of indicia could have a reflective coating at the base of the cavity and behind the luminescent epoxy in order to provide an illuminated real image of the indicia. The examiner disagrees as Robinson clearly discloses a reflective coating located on a "base" of the cavity, namely the upper peripheral edge of the cavity, as the coating is applied to a back surface of the epoxy after application to the cavities (see col. 2, lines 59-63).

17. Regarding claims 21 and 23, the applicant argues Woog does not disclose or contemplate at least one cavity, nor does it disclose or contemplate a cavity that extends substantially midway between the exterior facing surface and the interior facing surface, nor does it disclose or contemplate that at least one cavity defines at least one alpha-numeric indicia, nor does it

disclose the use of luminescent epoxy. The examiner disagrees as the term "inscription" is known in the art to imply engraving and thus inherently an inlaid cavity in the surface where the surface was engraved. Merriam Webster's Collegiate Dictionary (Tenth Addition) provides the following definition of "inscribe" which is "to write, engrave, or print as lasting record" The term "inscription" is being viewed as assuming its ordinary meaning which implies engraving and thus an inlaid cavity. This resultant cavity is being viewed as extending "substantially" midway between the faces of the plate 14. This resultant cavity further defines alpha-numeric indicia, namely the letters EXIT. The luminescent epoxy (luminescent paint) is then applied to and thus inherently fills the created cavity (see col. 2, lines 25-28).

#### ***Conclusion***

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Miller whose telephone number is (571) 272-7068. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor Batson can be reached on (571) 272-6987. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William L. Miller/  
Primary Examiner, Art Unit 3677